

responding to the Office Action (Paper No. 17) dated May 8, 1998 to November 8, 1998. Applicant is also filing concurrently herewith a Notice of Appeal.

In the Office Action, claims 35-47, 51, 52 and 58-143 were withdrawn from consideration pursuant to a constructive election under 37 CFR §1.142(b). As set forth on pages 2-3 of the Office Action, the Examiner considers claims added in the August 29, 1997 Amendment to be directed to four distinct inventions (a), (b), (c) and (d) from the invention originally claimed in the application. Applicant respectfully traverses this constructive election for the following reasons.

As for invention (a), the Examiner states that new independent claims 35 and 43 recite an operator input for requesting torque elimination, and that this function has not previously been claimed. However, the Examiner is respectfully requested to reconsider the constructive election holding in view of original application claims 24 and 29, which recite an operator input to request torque elimination. Claims 24 and 29 are reproduced below:

24. A vehicular semi-automated shift implementation system comprising:

a manually shifted transmission having an input shaft driven by a fuel-controlled engine, an output shaft and a plurality of selectively engageable and disengageable jaw clutches allowing selection of a plurality of drive ratios and neutral, said jaw clutches selectively positioned by a manually operated

shift lever having a plurality of selectable shift lever positions defining a shift pattern;

means for determining a level of engine fueling required to cause substantially zero torque to the input shaft under current vehicle operating conditions; and

means to sense conditions indicative of an operator intention to shift said transmission into neutral and effective, upon sensing conditions indicative of an operator intention to shift into neutral, to automatically cause said engine to be fueled to said level of engine fueling.

29. The system of claim 24 further comprising an intent-to-shift switch, said conditions comprising operation of said switch. (Emphasis added).

As set forth above, original application claims 27, 29 and 30 recite an operator input for requesting torque elimination (i.e., "to cause substantially zero torque"). Since the original claims 24 and 29 recite an operator input for requesting torque elimination, the Examiner is respectfully requested to reconsider and withdraw the construction election and examine claims 35 and 43, and claims 36-42 and 44-47 which depend on claim 35 or 43.

Further, regarding invention (d) - - a manually operated switch to indicate an intent to shift - - the Examiner is directed to original claims 27, 29 and 30 (reproduced below) which recite a manually operated intent-to-shift switch.

27. The system of claim 24 wherein said transmission is a splitter-type compound transmission and said means are effective, upon sensing conditions indicative of an operator intention to shift into neutral, to automatically preselect a splitter shift.

29. The system of claim 24 further comprising an

intent-to-shift switch, said conditions comprising operation of said switch.

30. The system of claim 29, wherein said switch comprises a manually operated button located on said shift lever. (Emphasis added).

As set forth above, claims 27, 29 and 30 recite the feature of an intent-to-shift switch which is a manually operated button. In view of original claims 27, 29 and 30, Applicant respectfully submits that the invention (d) set forth in the Office Action was contained in the original claims. Therefore, the Examiner is respectfully requested to reconsider and withdraw the constructive election and examine claims 58 and 75, and claims 59-74 and 76-78 which depend from claim 58 or 75.

Regarding the constructive election and the remaining claims 79, 83, 86, 91, 100, 105-107, 109, 129, 131, 132, 139 and 141-143, Applicant is preparing divisional applications containing these claims.

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the constructive election at least with respect to inventions (a) and (d) identified in the Office Action, and examine those claims identified in the Office Action corresponding to these inventions.

In the Office Action, the petition to correct the inventorship filed on August 29, 1997, to add Mr. McReynolds under 37 CFR 1.48(a) was objected to because of the reasons set

forth in item 2 on page 3 of the Office Action. Applicant respectfully requests reconsideration and withdrawal of this objection in view of the second verified statement of Mr. Genise filed concurrently herewith and the following remarks.

The Examiner states that the verified statement of Mr. Genise is deficient because it does not indicate that the inventor had reviewed and understood the contents of the specification including the claims, and whether he had reviewed the oath or declaration prior to its execution and if so, how the error occurred in view of such review. However, it is respectfully submitted that the original verified statement of Mr. Genise sets forth in particularity the facts as to how the error occurred. Specifically, the verified statement indicates that at the time of filing the present application (see, page 2 thereof) Mr. Genise did not recall a meeting which was attended by Mr. McReynolds, and in particular Mr. McReynolds contributions at that meeting. Mr. Genise further states that he recalled this meeting only after reviewing materials reflecting the subject matter of that meeting (the 8-11-93 fax). Accordingly, Mr. Genise's verified statement particularly points out why the error occurred at the time of filing the application. Further, while the Examiner indicates that the verified statement does not state that Mr. Genise reviewed the specification and claims and

USSN 08/666,164
AMENDMENT UNDER 37 CFR §1.116

declaration prior to filing, the declaration filed with the present application (of record in this application file) was executed by Mr. Genise and this document states that he reviewed the specification including the claims. Finally, there appears to be no requirement in 37 CFR 1.48(a) that the inventor submitting the verified statement needs to state that he reviewed the specification including the claims - no such requirement is needed because the original declaration executed by the inventor necessarily includes this statement.

Notwithstanding the above, and as mentioned above, Applicant is submitting herewith a second Verified Statement of Mr. Genise which adds that he reviewed and understood the specification including the claims, and that he reviewed the Declaration prior to filing the present application. In view of the foregoing, reconsideration and withdrawal of the objection to the petition to correct inventorship under 37 CFR 1.48(a) to add Mr. McReynolds is respectfully requested.

As to the petition to correct the inventorship under 37 CFR 1.48(c) to add Mr. Markyvech, Applicant is submitting herewith a verified statement by the original named inventor, Mr. Genise, a separate petition, and the required fee under 37 CFR 1.17(I). Applicant will also submit a new Declaration executed by all of the actual inventors.

In item 4 on page 4 of the Office Action, the Examiner objected to the incorporation of reference with respect to several cited U.S. Patents. During the telephone interview mentioned above, the Examiner stated his position that so long as these U.S. patents themselves incorporate matter by reference, incorporation by reference is improper under MPEP 608.01(p). Applicant respectfully disagrees with the Examiner's position for the following reasons.

MPEP 608.01(p) defines essential matter as follows:

"Essential material" is defined as that which is necessary to (1) describe the claimed invention, (2) provide an enabling disclosure of the claimed invention, or (3) describe the best mode (35 USC 112).

Thus, the MPEP 608(p) defines "essential material" or matter in the context of the claimed invention. Pursuant to the definition provided in the MPEP, it is only the subject matter of the claims that can possibly correspond to "essential matter".

MPEP 608.01(p) also states:

In any application which is to issue as a U.S. patent, essential material may not be incorporated by reference ... (3) a U.S. patent or application which itself incorporates "essential matter".

This provision of the MPEP applies in those cases in which the U.S. patent or application to be incorporated by reference itself incorporates by reference essential matter in the context of the claimed invention. That is, this provision does not

USSN 08/666,164
AMENDMENT UNDER 37 CFR §1.116

necessarily apply if the U.S. patent or application itself incorporates by reference just any material or matter; rather, it must itself incorporate "essential matter" - information that is essential to the claimed invention at issue. In the present case, while the U.S. patents indicated in item 4 on page 4 of the Office Action all incorporate matter by reference, it is respectfully submitted that none of these patents incorporates by reference "essential matter" - that is, information that is essential to the claims of the present application. As such, it is respectfully submitted that the provisions of MPEP 608.01(p) are not applicable in this case. In view of the above, reconsideration and withdrawal of the incorporation by reference objection is respectfully requested.

Referring to items 5 and 6 of the Office Action, Applicant has herein amended the application to indicate that the present application is a Continuation-In-Part of Applicant Nos. 08/649,830, 08/649,831 and 08/649,833, each filed April 30, 1996. In view of this amendment, the Examiner is respectfully requested to withdraw the objections in items 5 and 6 of the Office Action. Applicant respectfully submits that this amendment should not be construed that Applicant agrees or acquiesces with the Examiner's objections in items 5 and 6 of the Office Action.

Claims 1, 14, 16-18, 20, 22-24, 26-30, 33 and 54-57 were

USSN 08/666,164
AMENDMENT UNDER 37 CFR §1.116

rejected under 35 USC §102(e) as being anticipated by Palmeri et al '558. Further, claims 6, and 8 were rejected under 35 USC §103 as being unpatentable over Palmeri et al '558 in view of Nellums et al '070. Applicant respectfully traverses these §102 and §103 rejections for the following reasons.

As set forth on page 41 of the Amendment filed August 29, 1997, Applicant filed First through Fourth Requests For Interferences. The Fourth Request For Interference concerns the Palmeri et al patent - Patent No. 5,582,558. As also indicated on page 41 of the August 29, 1997 Amendment, Applicant filed with the Fourth Request, Declarations and documentary evidence establishing the date of invention of the present application to be prior to July 27, 1995 -- the filing date of the Palmeri et al patent. Accordingly, Applicant has established that the Palmeri et al patent is not prior art to the present application under 35 USC §102(e). Since the §102 and §103 rejections of record are each based on Palmeri et al, it is respectfully submitted that these prior art rejections should be withdrawn.

In view of the foregoing, it is respectfully submitted that all of the pending claims are in allowable condition. As such, the Examiner is respectfully requested to consider Applicant's Requests For Interferences. It is noted that the Examiner has already indicated that prosecution of claims 48-50 and 53 is

USSN 08/666,164
AMENDMENT UNDER 37 CFR §1.116

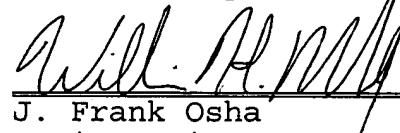
suspended and that these claims will be forwarded to the Board of Appeals for consideration of the First Request For Interference.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Request For Personal Interview

The undersigned attorney respectfully requests a personal interview with the Examiner. Accordingly, the Examiner is kindly requested to contact the undersigned at the local telephone number listed below to schedule such an interview.

Respectfully submitted,



J. Frank Osha
Registration No. 24,625
William H. Mandir
Registration No. 32,156

SUGHRUE, MION, ZINN,
MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

Date: November 4, 1998